

Appl. No. 10/735,613  
Amendment dated: March 6, 2006  
Reply to OA of: November 7, 2005

### **REMARKS**

This is in response to the Official Action of November 7, 2005. Applicants have amended the claims in order to more precisely define the scope of the present invention, taking into consideration the outstanding Official Action.

Specifically, Applicants have amended claim 1 to recite that the rare earth magnet is a neodymium iron boron magnet. Support for this amendment can be found throughout the specification as originally filed. Accordingly, Applicants respectfully submit that all claims now pending in the present application are in full compliance with the requirements of 35 U.S.C. §112 and are clearly patentable over the references of record.

The rejection of claims 6 and 8 under 35 U.S.C. §102(b) as being anticipated by Sakurai has been carefully considered but is most respectfully traversed in light of the amendments to the claims and the following comments.

Applicants wish to direct the Examiner's attention to MPEP § 2131 which states that to anticipate a claim, the reference must teach every element of the claim.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed.Cir. 1990).

The Official Action urges that Figure 4(a) of Sakurai is an embodiment where each spherical magnet may have a colored coating and the magnets are taught to have

a powerful magnetic force, e.g., a neodymium magnet. Applicants specifically traverse this rejection for the following reasons.

First, as discussed above, Applicants have amended claim 6 to recite that the rare earth magnet is a neodymium iron boron magnet. As is inherently acknowledged in the §102(b) rejection over Sakurai, this feature is not disclosed in Sakurai (see, e.g., claim 12 was not included in the §102(b) rejection over Sakurai). Therefore, Applicants respectfully submit that Sakurai cannot properly support a §102(b) rejection of claim 6 according to the guidelines set forth in MPEP §2131. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Further, Applicants note that Figure 4(a) is an example of the bracelet shown in Figure 1, wherein the non-magnetic casing 1 of each unit is a different color (see paragraph [0009]). Therefore, Figure 4(a) clearly does not show spherical magnets, as the magnets 2 shown in Figure 1 of Sakurai are clearly non-spherical, thin, flat shaped magnets. Accordingly, Applicants respectfully submit that Sakurai clearly fails to disclose every element of claim 6 and 8, and should therefore be withdrawn.

As the limitation of claim 12, now incorporated into claim 6, was previously rejected under 35 U.S.C. §103(a) as being unpatentable over Sakurai, Yellen, Ishikawa and Hoffman, Applicants would like to address this rejection in order to demonstrate that these references fail to disclose or suggest every element of presently amended claim 6.

The outstanding Official Action refers back to the Official Action of June 24, 2005 in providing support for the rejection of claims 7, 9, 10, 12 and 13. The Official Action of June 24 urges, in part, that Ishikawa discloses the use of rare earth magnets in jewelry to promote health. The Official Action of June 24 also urges that rare earth magnets are noted for their larger coercive force. As Applicants' representative pointed out during the personal interview, the Official Action of June 24 fails to address where the references disclose a neodymium iron boron magnet or a samarium cobalt magnet.

The outstanding Official Action notes in responding to Applicants' arguments that the magnets of claims 12 and 13 are species of rare earth magnets in a genus species

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relationship. The Examiner cites MPEP §2144.08 in support of this statement. Therefore, it appears that the only support provided for a teaching of a neodymium iron boron magnet is the assertion that a neodymium iron boron magnet is a species of a rare earth magnet and both Sakurai and Ishikawa disclose rare earth magnets. Applicants specifically traverse this portion of the §103(a) rejection.

Applicants have reviewed MPEP §2144.08, and note that several requirements for claiming a species of a genus is obvious are missing from the outstanding Official Action. The patentability of a claim to a specific compound or subgenus embraced by a prior art genus should be analyzed no differently than any other claim for purposes of 35 U.S.C. §103. Therefore, **the fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness.** *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) ("The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious."); *In re Jones*, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992) (Federal Circuit has "decline[d] to extract from *Merck & Co. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989)] the rule that... regardless of how broad, a disclosure of a chemical genus renders obvious any species that happens to fall within it."). See also *In re Deuel*, 51 F.3d 1552, 1559, 34 USPQ2d 1210, 1215 (Fed. Cir. 1995).

To establish a *prima facie* case of obviousness in a genus-species chemical composition situation, as in any other 35 U.S.C. §103 case, it is essential that Office personnel find some motivation or suggestion to make the claimed invention in light of the prior art teachings. See, e.g., *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996). Further, the mere fact that a prior art genus contains a small number of members does not create a *per se* rule of obviousness. Some motivation to select the claimed species or subgenus must be taught by the prior art. See, e.g., *Deuel*, 51 F.3d at 1558-59, 34 USPQ2d at 1215.

Even a brief review of the outstanding Official Action reveals that the burden to establish a *prima facie* case of obviousness according to the requirements set forth in

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MPEP §2143 has not been established. While it may be true that neodymium boron iron magnet is a species of the rare earth magnet genus, no motivation is provided in the Official Action for why one of ordinary skill in the art would specifically select amongst all of the species included within the rare earth magnet genus that species which is presently claimed in the instant application. Absent this motivation, along with the other requirements of prima facie case of obviousness, it is clear that a proper §103(a) rejection has not been set forth. Accordingly, Applicants respectfully request that this rejection be withdrawn.

In view of the above comments and further amendments to the claims, favorable reconsideration and allowance of all of the claims now present in the application are most respectfully requested.

Respectfully submitted,

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